

Appl. No. 10/010,251
Amdt. dated October 3, 2003
Reply to Office Action of July 3, 2003

REMARKS/ARGUMENTS

Claims 8 - 13 and 21 - 22 are pending in this application.

Reconsideration of the present application in view of the following remarks is respectfully requested.

A. Rejection Of Claims 8 - 10, 12, and 21 - 22 Under 35 U.S.C. § 102(b)

Claims 8 - 10, 12, and 21 - 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,114,072 issued to Cleveland (hereinafter referred to as the "Cleveland reference"). Applicant respectfully traverses the rejection as it may apply to the present claims.

The Examiner states that the Cleveland reference discloses a roll for papermaking having indentions of depth from about 0.002 in. to 0.02 in., and a diameter from about 0.005 in. to 0.04 in.

Applicant's claimed structure is not anticipated by the Cleveland reference. The Cleveland reference teaches a steel roll having a roughened surface which is then chrome plated. The dimensions of the surface roughness indentations are disclosed as from 0.005 inch to 0.040 inch in diameter and about one-half that depth (0.127 mm to 1.016 mm diameter and 0.064 mm to 0.508 mm deep). The surface roughness of the steel roll is in the form of indentations - not indentations and protuberances. In addition, the Cleveland reference teaches contacting the paper web having a water content of between 65 and 70 percent. As such, Applicant points out that the wet webs are not have dried sufficiently to have formed the fiber to fiber bond; therefore disruption of such bonds cannot take place. Accordingly, independent Claims 8 and 21 - 22 and dependent Claims 9 - 10 and 12 are believed to be novel and nonobvious over the cited Cleveland reference.

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Based on the foregoing remarks, the § 102(b) rejection to Claims 8 - 10, 12, and 21 - 22 should be withdrawn.

B. Rejection Of Claims 11 and 13 Under 35 U.S.C. § 103(a)

Claims 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Cleveland reference in view of U.S. Patent No. 2,498,275 issued to Johnson (hereinafter referred to as the "Johnson reference"). Applicant respectfully traverses the rejection as it may apply to the present claims.

The Examiner stated that the Cleveland reference was as applied to Claim 8 above. The Examiner stated that the Cleveland reference failed to disclose a method of making depressions by stippling. The Examiner further stated that the Johnson reference disclosed a method of making depressions by stippling in a surface of a product. The Examiner states that it would be obvious to one skilled in art, at the time the invention was made, to combine the teachings of the Johnson and Cleveland references because such a combination would provide a means of creating delicate depressions in the roll disclosed in the Cleveland reference.

Applicant submits that the Cleveland reference in view of the Johnson reference does not establish a prima facie case of obviousness. The Johnson reference does not disclose stippling as a means of making depressions in a surface of a product, especially paper products. The Johnson reference teaches rolling block structures to form propeller blades or other elongated constructions. In addition, the Applicant points out that the Johnson reference discloses stippling in Figures 25 and 32 as a means of indicating the location of a parting agent in those figures. "Prior to the time that the blocks, the center plate and the mandrels were assembled as described above, a parting agent, as indicated by stippling in Figs. 25 and 32, is applied to selected surfaces thereof." The Cleveland and Johnson references do not suggest the present invention. For the reasons stated above, the Applicant submits that neither the Cleveland reference nor the Johnson reference would work as described or obtain the recited benefits if so modified. Accordingly, dependent Claims 11 and 13 are believed to be novel and nonobvious over the cited references.

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Ecologchem Inc. v. Southern California Edison Co., 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000):

We have previously held that "[t]he suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1456; see also *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification...of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

There must be some logical suggestion or motivation to justify a combination or modification of the cited art references. The Cleveland reference cited by the Examiner provides no impetus to arrive at Applicant's claimed invention, especially in view of the remarks made above regarding the Cleveland reference. The Johnson reference cited by the Examiner provides no impetus to arrive at the Applicant's claimed invention. In addition, one skilled in the art would not logically look to or be motivated to a reference disclosing a method of forming block material into propellers for suggestions to modify a paper making process. Therefore, one skilled in the art, aware of the Cleveland reference and the Johnson reference would not have arrived at the claimed invention. Consequently, based on the foregoing remarks, the Section 103(a) rejection of Claims 11 and 13 should be withdrawn.

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C. Conclusion

The application now contains Claims 8 - 13 and 21 - 22 which are believed to be in condition for allowance. Applicant would like to thank the Examiner for the careful attention paid to the present application. Early allowance of the claims in view of the above remarks is earnestly requested.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3616.

Respectfully submitted,

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